

REMARKS

This Response is submitted in reply to the Office Action dated May 24, 2004. The Claims have not been amended. No fee is due in connection with this Response. Please charge deposit account number 02-1818 for any insufficiency or to credit any overpayment.

Claims 1, 3 to 5, 8, 9, 11 to 19 and 21 to 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,491,584 to Graham et al. ("*Graham*") in view of U.S. Patent No. 6,135,884 to Hedrick et al. ("*Hedrick*"). Claims 2, 6, 7, 10 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of U.S. Patent No. 6,203,429 to Demar et al. ("*Demar*"). Claims 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of U.S. Patent No. 6,533,658 to Walker et al. ("*Walker*"). Applicants respectfully disagree with and traverse these rejections for at least the reasons provided below.

A. The Motivation For Combining *Hedrick* with *Graham* Is Improper

Page 4 of the Office Action states that "one would be motivated to combine the teachings of *Hedrick* with the disclosed invention of *Graham* in order to increase the difficulty of retriggering the bonus and attract more game players to the gaming machine." This is not a proper motivation to combine the references. If a game designer increases the difficulty of retriggering a bonus, that will not attract more players to the gaming machine. The exact opposite is generally true. Players are generally

more attracted to gaming machines with more easily triggered and retriggered bonus games. Accordingly, this motivation is improper.

Moreover, such general statements of the motivation to combine references are not legally proper under Federal Circuit law. Obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01. The Patent Office must show the “reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art” and combine those elements in the same manner as the claimed invention. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). These “reasons” need to be specific reasons, not general overarching reasons for combining two references or groups of references. There are three possible sources for determining whether a motivation to combine references exists: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. MPEP § 2143.01; *In re Rouffet*, 149 F.3d at 1357. If there is no motivation to combine the cited references, then the obviousness rejection is improper. The general motivation to combine *Graham* and *Hedrick* “to attract more players to the gaming machine” in the Office Action is improper and should respectfully be withdrawn.

Similarly, the general notification to combine *Graham*, *Hedrick* and *Demar* of providing “gaming players with higher payouts in bonus games and heighten the exhilaration of the game” is legally insufficient.

B. The Combination of *Graham* and *Hedrick* Does not Teach the Claimed Invention

Claim 1 is directed to a gaming device including a processor, a primary game controlled by the processor and a secondary game controlled by the processor. The primary game includes a secondary game triggering event which triggers the secondary game. The secondary game includes a secondary game re-triggering event which re-triggers the secondary game. The secondary game also includes an accumulator adapted to accumulate secondary game re-triggering symbols. The gaming machine provides a secondary game re-trigger when the accumulator accumulates at least two secondary game re-triggering symbols in at least two activations of the secondary game.

Graham discloses a gaming machine including a base game and a series of free games. The gaming machine provides an initial series of free games to a player when a trigger condition occurs in the base game. (Col. 3, lines 5 to 10) A subsequent series of free games is awarded to the player if the same trigger condition occurs in the initial series of free games. Pages 3 to 4 of the Office Action state that *Graham* discloses:

an accumulator in the secondary game to accumulate secondary game symbols, an accumulated symbol display that displays the secondary game symbols that accumulated by a player in the secondary game, and the number of accumulated secondary game symbols are predetermined or randomly determined, and each secondary game symbol

accumulated by the accumulator is a different symbol and is arranged in predetermined order.

Page 4 of the Office Action further states that *Graham* discloses that:

“the trigger condition may be the appearance of **three scatter** symbols anywhere on the display”. *Graham* is disclosing that the scatter symbols are an accumulation of symbols that are not necessary on a particular payline. The scatter symbols may fall on the same payline, which would also be a symbol combination. This feature anticipates the claim limitation of having a re-triggering accumulation symbols and re-triggering symbol combinations. [Emphasis in Original]

Applicants respectfully disagree with this interpretation of *Graham*. *Graham* does not disclose, teach or suggest an accumulator or the accumulation of symbols because the scatter pay in *Graham* does not provide any benefit for less than an occurrence of all of the scatter pay symbols. In other words, if three scatter symbols in *Graham* are required to occur to retrigger the free spins and two of the scatter pay symbols occur, the two scatter pay symbols are not accumulated or saved. The re-trigger is not provided to the player and the player has not accumulated any scatter pay symbols toward the re-trigger. On the next spin, the player must obtain all three scatter pay symbols. This feature of the *Graham* game is an all or nothing feature. The *Graham* game does not provide any benefit for obtaining less than all of the scatter pay symbols and therefore does not disclose, teach or suggest an accumulation of scatter pay symbols as in the claimed invention. Accordingly, for at least this reason alone, the combination of *Graham* and *Hedrick* does not render the claimed invention obvious.

Graham and *Hedrick* do not disclose all of the elements of Claim 1 and Claims 2 to 4, which depend from Claim 1. Therefore, Claim 1 and Claims 2 to 4 are each in condition for allowance.

Independent Claims 5, 14, 15, 16, 17, 19, 21 and 23 include certain similar elements to Claim 1, and specifically, the element of an accumulator in the secondary game which is adapted to accumulate secondary game retriggering symbols, wherein a secondary game retrigger is provided to a player when a player accumulates a plurality of secondary game retriggering symbols in at least two activations of the secondary game. As described above with respect to Claim 1, the combination of *Graham* and *Hedrick* does not disclose, teach or suggest this. For at least these reasons, Claims 5, 14, 15, 16, 17, 19, 21 and 23, and Claims 6 to 13, 18, 20, 22, 24 to 26, which depend therefrom, each patentably distinguished over the combination of *Graham* and *Hedrick* and are each in condition for allowance.

Claims 2, 6, 7, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of *Demar*. Claim 2 depends from Claim 1. Claims 6, 7 and 10 depend from Claim 5. Claim 20 depends from Claim 19. Applicants respectfully submit that Claims 2, 6, 7, 10 and 20 are allowable for at least the reasons set forth above with respect to Claims 1, 5 and 19 because the combination of *Graham*, *Hedrick* and *Demar* does not disclose, teach or suggest the novel elements of Claims 2, 6, 7, 10 and 20 in combination with the novel elements of Claims 1, 5 and 19, respectively.

Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of *Walker*. Claims 25 and 26 depend from Claim 23. Applicants respectfully submit that Claims 25 and 26 are allowable for at least the reasons set forth above with respect to Claim 23 because the

combination of *Graham, Hedrick* and *Walker* does not disclose, teach or suggest the novel elements of Claims 25 and 26 in combination with the novel elements of Claim 23.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Adam H. Masia
Reg. No. 35,602
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4284

Dated: August 23, 2004